UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,970	11/16/2000	Yutaka Nagai	500.37136CX1	5631

20457 7590 05/15/2003

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

EXAMINER	
ROSEN, NICHOLAS D	
ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/712,970	NAGAI ET AL.	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/290,251* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claims 1-14 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (U.S. Patent 6,209,092) in view of Suzuki et al. (U.S. Patent 5,699,474). Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, the video data and/or audio data being generated

by superimposing information concerning copying consent on a digitized video signal or audio signal (Abstract; see also column 2, line 26, through column 3, line 67), the reproduction apparatus comprising: reproducing means for reproducing the superimposed information concerning copying consent from the processed data (Abstract; column 5, lines 41-63); and output control means for performing output control of the reproduced data based on the reproduced information concerning copying consent (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45); wherein the output control means stops outputting the data if both (1) the data was reproduced from a medium dedicated to reproduction and (2) the reproduced information concerning copying consent indicates that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). Linnartz does not disclose the other elements of claim 1; however, Suzuki teaches demodulating means for demodulating data modulated in accordance with a presumed modulation rule; temporal store means for storing the data demodulated by the demodulating means; and error-correcting means for error-correcting the demodulated data stored in a temporal store means, the error-corrected data being stored in a temporal store means (column 9, lines 43-50; refer also to Figure 5). Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to include demodulating means for the obvious advantage of transforming the data into convenient (digital) form; error-correcting means for the obvious advantage of correcting data errors; and temporal

store means for the obvious advantage of manipulating data for demodulation, error-correction, copying consent checking, etc.

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz and Suzuki as applied to claim 1 above, and further in view of official notice. As per claim 2, neither Linnartz not Suzuki expressly discloses that said temporal store means is a RAM, but official notice is taken that the use of RAM to store data, especially to store data temporarily, is well known. Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to have the temporal store means be a RAM, for the obvious advantage of temporally storing the data in a convenient, widely available, and re-usable type of memory.

As per claim 3, neither Linnartz nor Suzuki discloses that the demodulating means, the error-correcting means, and the copying consent information reproduction means are connected to said RAM, but official notice is taken that it is well known to have data processing means connected to a RAM. Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to have the demodulating means, the error-correcting means, and the copying consent information reproduction means be connected to said RAM, for the obvious advantage of enabling the various data processing means read from and write to the RAM in order to carry out their functions with regard to the data.

As per claim 4, neither Linnartz nor Suzuki discloses that said RAM is constituted by a single RAM, but official notice is taken that it is well known for a RAM to be

constituted by a single RAM (e.g., one disk). Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to have the RAM be constituted by a single RAM, for the obvious advantages of economizing on RAM's and enabling the data processing to be conducted in a simple and convenient manner.

As per claim 5, neither Linnartz nor Suzuki discloses that the copying consent information reproducing means, the demodulating means, the error-correcting means, and the RAM are integrated in a single semiconductor device, but official notice is taken that it is well known to integrate a multiplicity of data processors and memory into a single semiconductor device (as witness the terms "integrated circuit" and "computer on a chip"). Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to have the copying consent information reproducing means, the demodulating means, the error-correcting means, and the RAM integrated in a single semiconductor device, for the obvious advantages of simplifying chip manufacture, not needing to connect a number of chips to one another, increased processing speed (since signals would not have to be sent from one chip to another), and enhanced security, in that signals within a single chip cannot be as readily detected and falsified as signals between separate chips or other arrangements of circuit elements.

Claim 6

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (U.S. Patent 6,209,092) in view of Suzuki et al. (U.S. Patent 5,699,474) and official

notice. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, the video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal or audio signal (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: reproducing means for reproducing the superimposed information concerning copying consent from the processed data (Abstract; column 5, lines 41-63); and output control means for performing output control of the reproduced data based on said reproduced information concerning copying consent (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45); wherein the output control means stops outputting the data if both (1) the data was reproduced from a medium dedicated to reproduction and (2) the reproduced information concerning copying consent indicates that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). Linnartz does not disclose the other elements of claim 1; however, Suzuki teaches demodulating means for demodulating data modulated in accordance with a presumed modulation rule; temporal store means for storing the data demodulated by the demodulating means; and error-correcting means for error-correcting the demodulated data stored in a temporal store means, the error-corrected data being stored in a temporal store means (column 9, lines 43-50; refer also to Figure 5). Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to include

demodulating means for the obvious advantage of transforming the data into convenient (digital) form; error-correcting means for the obvious advantage of correcting data errors; and temporal store means for the obvious advantage of manipulating data for demodulation, error-correction, copying consent checking, etc.

Neither Linnartz nor Suzuki discloses that the demodulating means, the temporal store means, the error-correcting means, the copying consent information reproducing means, and the reproduction stopping means are integrated in a single semiconductor device. However, official notice is taken that it is well known to integrate a multiplicity of data processors and memory into a single semiconductor device (as witness the terms "integrated circuit" and "computer on a chip"). Hence, it would have been obvious to one of ordinary skill in the art of data reproduction and copy protection at the time of applicant's invention to have the demodulating means, the temporal store means, the error-correcting means, the copying consent information reproducing means and the reproduction stopping means integrated in a single semiconductor device, for the obvious advantages of simplifying chip manufacture, not needing to connect a number of chips to one another, increased processing speed (since signals would not have to be sent from one chip to another), and enhanced security, in that signals within a single chip cannot be as readily detected and falsified as signals between separate chips or other arrangements of circuit elements.

Claims 7-11

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (U.S. Patent 6,209,092) in view of Suzuki et al. (U.S. Patent 5,699,474). Claim 7 is

closely parallel to claim 1, and rejected on essentially the same grounds set forth above with regard to claim 1.

Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz and Suzuki as applied to claim 7 above, and further in view of official notice. Claims 8-11 are closely parallel to claims 2-5, respectively, and rejected on essentially the same grounds set forth above with regard to claims 2-5.

Claim 12

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (U.S. Patent 6,209,092) in view of Suzuki et al. (U.S. Patent 5,699,474) and official notice. Claim 12 is closely parallel to claim 6, and rejected on essentially the same grounds set forth above with regard to claim 6.

Claim 13 and 14

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz (U.S. Patent 6,209,092) in view of Suzuki et al. (U.S. Patent 5,699,474). Claims 13 and 14 are closely parallel to claim 1, and rejected on essentially the same grounds set forth above with regard to claim 1.

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hashimoto et al. (U.S. Patent 6,526,146) disclose an information recording system. Kato et al. (U.S. Patent 6,556,679) disclose a copy-guard system and information recording medium used in that system.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and for After Final communications. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

The new mailing address for the Patent Office is:

Commissioner for Patents

P.O. Box 1450

Alexandria VA 22313-1450

As of May 1, 2003, the former addresses, Washington DC 20231 and P.O. Box 2327 Arlington VA 22202, should **not** be used.

Papers can be hand-delivered to the Technology Center 3600 receptionist, 7th floor, Crystal Park 5, 2451 Crystal Drive, Arlington VA 22202.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Nicholas D. Rosen

Nicholas D. Rosen
Primary Examiner
May 14, 2003